



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application No. 10/004,271

Applicant: CAUCHON, Mark et al. Art Unit: 3845
Filed: 31 October 2001 Examiner: Laurie Anne Ries
For: SERVICE PROVIDER NETWORK FOR LEGAL SERVICES WITH
DIRECT BROWSER DELIVERY OF RICH TEXT FORMAT
DOCUMENTS

* * * *

DECLARATION UNDER 37 CFR 1.131

To The Honorable Commissioner
of Patents and Trademarks
Washington, D.C. 20231

Sir:

I, Mark P. Cauchon, declare that:

1. I currently reside at 1 Whitfield Road, Baltimore, MD 21210. I have personal knowledge of the facts set forth herein.
2. I am an inventor of record and founder and President of Legal Advice Line, Inc. ("LAL"), 110 West Road, Suite 217, Towson, MD 21204. LAL is the licensee and operator of the service provider network shown and described in the above-captioned patent application.
3. My job function entailed original development of said service provider network.
4. I am familiar with the Office Action dated 16 September 2004, which the Patent and Trademark Office mailed in regard to the above-captioned patent application. I am cognizant that desktop document assembly systems have been in existence since the advent of the PC. Sometimes this earlier software was purchased separately as an application, and sometimes it was imbedded in a product offering like Quicken Family Lawyer(tm). The essence of these forerunner systems was (and still is) a database of 'skeleton' documents, a questionnaire form that allows the user to populate the variables in

WFC

Serial No. 10/004,271
Applicant: CAUCHON, Mark et al.
Art Unit: 3845
Examiner: Laurie Anne Ries
Page 2

the database, a series of database commands that personalize the skeleton to create a document based on the user's inputs and a word processor that formats the database output into a finished document. I participated in building an Internet Service Provider Network, which is a substantially different endeavor. Instead of skeleton documents residing on a database on the user PC, they reside on a server and are accessed via the Internet. Instead of a questionnaire that directly populates the database- it is now on an HTML page on the user's computer and the information is transmitted via the Internet to the server. The database commands that personalize the skeleton document must deal with a much greater level of complexity when receiving inputs from an HTML page: for one thing the provider system must check to see if all the data that was transmitted from the user's computer has actually arrived at the server. One of the most dramatic innovations in our system, as set forth in the current claims, resides in the word processing. We had to devise a technique to deliver the personalized legal document to the user so that the user could employ whatever word processing capability resides on the user's system. This last point is very important because there had been several unsatisfactory techniques employed previously. One was to send the personalized output from the database on the server to the user via HTML pages. Unfortunately, the pages do not paginate and have headers and footers on them so the document is not of a quality required in the context of producing legal documents, where formatting is essential. Another method was to have the client download a 'reader' that would take the server output and transform it into a document. We felt that this was too cumbersome. Our innovation allows us to send the information in RTF so the client's word processor- whether it is Microsoft Word(tm), Word Perfect(tm) or Lotus Notes (tm)will paginate the document into a finished document. This makes the client experience similar to a desktop document assembly system but now we can make sure the most up to date form is available to the end user- rather than their reliance on purchasing new versions of the software every year, as with Quicken Family Lawyer(tm).

MFL

Serial No. 10/004,271
Applicant: CAUCHON, Mark et al.
Art Unit: 3845
Examiner: Laurie Anne Ries
Page 2

Our current claims center on this technology in the context of our Service Provider Network.

5. The Examiner relies heavily on Heston (U.S. Publication 2002/0019741 A1) as disclosing all elements of claim 1 except that "the legal forms are generic and stored in a database, and Heston also does not disclose expressly receiving user information from a user over an electronic communications link and packetizing the user information, rendering a personalized legal document for the user by selectively merging the packetized user information into the generic legal form, and delivering the personalized legal document to the user in a secondary browser window on the user's computer screen by RTF document export." The Heston application derives priority from a provisional application 60/216,646 filed July 7, 2000. The present application derives priority from a provisional application 60/244,676 filed October 31, 2000. However, development of the current invention as claimed began in 1999 and was completed in late 1999. The current system was fully operative by December of 1999, as evidence by our first on-line sale of a legal document to a paying customer using the current system. Our first on-line sale of a legal document using the system was a Maryland Adult Guardianship form sold on December 8, 1999. Appendix A is a standard print record of LAL's Retail Document Sales covering the period starting on 7/1/1999 to 12/8/99, inclusive of said first on-line sale (Maryland Adult Guardianship form sold on December 8, 1999). This record was printed from existing sales data in our system and has not been manually altered in any way. The first-cited Maryland Adult Guardianship form was sold and delivered in RTF format using our service provider system as presently claimed, and it is self-apparent that the system was in development for months before that time, and fully operative at the point that it was launched and utilized. These facts corroborate our conception and reduction to practice at least as early as December 8, 1999, a full seven months earlier than the priority date of the Heston U.S. Publication 2002/0019741. We thereafter worked diligently to prepare and file the above-captioned application, approaching the attorney-of-record in mid-2000, authorizing and working toward

114

Serial No. 10/004,271
Applicant: CAUCHON, Mark et al.
Art Unit: 3845
Examiner: Laurie Anne Ries
Page 2

the preparation and filing of U.S. provisional application 60/244,676 on October 31, 2000.

6. I believe that the foregoing showing of facts is such, in character and weight, as to establish reduction to practice prior to the effective date of the Heston reference, as well as conception of the present invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the current application.

* * * * *

I further declare that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or by both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the above-referenced patent.

Signature:



Mark P. Cauchon
President, Legal Advice Line, Inc.

Date: 1/17/05

X

Retail Document Sales

Covering the period starting on **7/1/1999** for **365** days.

Completed Sales

ClientID	SessionID	PayType	\$ Billed	ClientName	Date.....	AuthCode	PNRef	Done	
10	890696578d	CreditCard	29.00	GloriaJeanWatkins	12/8/1999 11:20:53 AM	008808	PD0302824840	True	GloriaJean
15	890696890d	CreditCard	29.00	JosephGentile	12/15/1999 3:43:51 PM	015656	PA0305054001	True	JosephGe
107	129449585d	CreditCard	39.00	MauriceE.Jefferson	2/2/2000 2:10:59 AM	033137	PA0306128415	True	MauriceE.
114	129449757d	CreditCard	29.00	MarlaRizzoWolfe	2/3/2000 1:52:06 PM	003384	PA0306177355	True	MarlaRizz
117	129449857d	CreditCard	29.00	T'ChallaJosannaTurnquist	2/4/2000 3:33:02 PM	464090	PD0304804594	True	T'ChallaJo
128	375692299d	TeleCheck	29.00	RosilandA.Russell	2/14/2000 3:39:52 PM	Approved	PD0205061455	True	RosilandA.
129	375692373d	CreditCard	29.00	JamesJant	2/15/2000 9:45:59 AM	015641	PA0306596443	True	JamesJant
131	375692432d	CreditCard	29.00	SarahSargentMontgomery	2/15/2000 4:29:03 PM	025179	PA0306611964	True	SarahSarg
142	554931901d	CreditCard	29.00	IngerMarieForland	2/23/2000 9:35:59 PM	402714	PD0305344161	True	IngerMarie
148	554932149d	CreditCard	29.00	AndrianAmyWashington	2/27/2000 7:16:51 PM	041776	PD0305442776	True	AndrianArr
159	554933055d	CreditCard	39.00	CatherineElizabethIngram	3/8/2000 8:13:18 PM	015654	PA0307427476	True	CatherineE
163	554933472d	CreditCard	29.00	CristinaMarieJohnson	3/14/2000 2:28:44 PM	890912	PD0305749401	True	CristinaMa
164	554933472d	CreditCard	29.00	CristinaMarieAmaro	3/14/2000 2:52:23 PM	890912	PC0300663691	True	CristinaMa
168	554933606d	CreditCard	29.00	JaiaCox	3/15/2000 10:48:05 AM	094803	PA0307612263	True	JaiaCoxKi
170	554933675d	CreditCard	39.00	AngeliqueBrooks	3/15/2000 8:32:27 PM	014442	PC0300724190	True	AngeliqueB
173	554933738d	CreditCard	39.00	BarbaraSueMoore	3/16/2000 11:02:24 AM	063241	PA0307645841	True	BarbaraSu
183	554934065d	CreditCard	29.00	RobertMorrisGordin	3/20/2000 10:50:19 AM	020268	PA0307733629	True	RobertMor
206	554934690d	CreditCard	39.00	JanetP.Harmon	3/27/2000 3:31:36 PM	027904	PA0307927665	True	JanetP.Ha
226	554935575d	CreditCard	29.00	NICOLEDANIELLECLARK	4/4/2000 11:21:22 PM	087686	PD0306293703	True	NICOLED/
288	554936036X	TeleCheck	25.00	MARJORIEANNBLACKWELL	4/10/2000 12:15:35 PM	Declined	PC0201390576	False	MARJORII
294	554936122	CreditCard	25.00	MARJORIEANNBLACKWELL	4/11/2000 10:34:26 AM	Declined	PC0301414039	False	MARJORII
296	554936129	TeleCheck	25.00	MARJORIEANNBLACKWELL	4/11/2000 10:53:27 AM	Declined	PC0201414663	False	MARJORII
297	554936150	CreditCard	29.00	ToniDanetteRichardson	4/11/2000 1:16:49 PM	Declined	PD0306529305	False	ToniDanet
319	554936227	CreditCard	29.00	ToniDanetteRichardson	4/11/2000 10:51:47 PM	Declined	PD0306544469	False	ToniDanet
321	554936256d	CreditCard	29.00	AlfredE.Newmann	4/12/2000 10:41:37 AM	108118	PA0308402019	True	AlfredE.Ne
322	554936266	CreditCard	29.00	ToniDanetteRichardson	4/12/2000 11:48:03 AM	Declined	PC0301442297	False	ToniDanet
349	554936617d	CreditCard	29.00	OlukayodeMartinAlade	4/17/2000 1:00:10 PM	220757	PA0308537865	True	Olukayode
353	554936698d	CreditCard	29.00	MelanieNoelColeman	4/18/2000 10:46:02 AM	018544	PA0308571106	True	MelanieNo
358	554936736d	CreditCard	25.00	HelenMcCree	4/18/2000 6:17:12 PM	961208	PD0306782563	True	HelenMcC
502	614530641d	CreditCard	15.75	AmeciaDanielleStephens	5/11/2000 8:28:09 AM	011598	PD0307687329	True	AmeciaDai
518	614530766d	CreditCard	15.75	LisaCampeau	5/12/2000 2:42:19 PM	012724	PC0302072816	True	LisaCampe
574	614531592d	CreditCard	31.50	JEROMEDEAN	5/23/2000 3:02:06 PM	005562	PC0303524544	True	JEROMEDE
640	614531825d	CreditCard	39.00	RonaldandKathleenM.Bell	5/25/2000 3:17:27 PM	114963	PA0310428386	True	Ronaldand
648	614531885d	CreditCard	15.75	MobiWilliamKolbon	5/26/2000 10:58:26 AM	026677	PC0304060843	True	MobiWillia
668	614532007d	CreditCard	26.25	DelmerJohnTrester	5/27/2000 2:55:33 PM	027706	PA0310551394	True	DelmerJoh
711	614532389d	CreditCard	30.45	TheresaAnnInskeep	6/1/2000 10:52:01 PM	074870	PA0310825163	True	TheresaAr
714	614532396d	CreditCard	30.45	DelmerJohnTrester	6/1/2000 11:40:15 PM	001172	PA0310825848	True	DelmerJoh
722	614532450d	CreditCard	15.75	MelissaMarieSpindler	6/2/2000 8:28:55 PM	002423	PC0304649995	True	MelissaMa
771	614532808d	CreditCard	39.00	EricMcKinleyYarbough	6/7/2000 2:05:24 PM	154561	PA0311052839	True	EricMcKinl
785	614532906d	CreditCard	30.45	SiYoungLee	6/8/2000 1:23:07 PM	705095	PA0311111417	True	SiYoungLe
884	421557324d	CreditCard	30.45	JohannaLucindaGoderre	6/19/2000 7:43:31 PM	019877	PA0311747909	True	JohannaLu
963	421557906	TeleCheck	30.45	jamesbensonsheetsjr	6/27/2000 10:49:26 AM	Declined	PC0206790880	False	jamesbens
965	421557965X	CreditCard	30.45	MariaTeresaDolmoLacayodeBiddy	6/27/2000 7:09:49 PM	Declined	PA0312135024	False	MariaTere